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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,497	12/05/2003	Shuji Nakaya	8861-477US (P32184-01)	9714

570 7590 05/01/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

LANE, JOHN A

ART UNIT	PAPER NUMBER
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2185

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,497	Applicant(s) NAKAYA ET AL.	
	Examiner Jack A. Lane	Art Unit 2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/5/03(1pg)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to the preliminary amendment filed 12/05/2003. Claims 1-5 are presented for examination. Figures 2, 3, 13 and 14 are presented as prior art and should be labeled as such.
2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119. The certified copy has been received.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The Abstract of the Disclosure is objected to because the Abstract should be limited to a single paragraph and not more than 150 words. If a new Abstract is submitted it must be on a separate sheet. Correction is required. See M.P.E.P. 608.01(b).
5. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The examiner requests, in response to this Office action, any documentation known to qualify as prior art under 35 U.S.C. sections 102 or 103 with respect to the invention as defined by the independent(s) claims. That is, any prior art (including any documentation used to develop

the disclosed/claimed subject matter, background art and any products for sale) similar to the claimed invention that could reasonably be used in a 102 or 103 rejection. Furthermore, if applicant has knowledge of/been made aware of an assertion (perhaps by another examiner in a rejection or in a court proceeding) that a prior art element/device corresponds to or anticipates a presently claimed limitation then such assertion must be provided to the examiner. This request does not require a search. Support for this request is derived from 37 CFR 1.56 and 1.105, however, it is not intended to interfere with or go beyond that required under 37 CFR 1.56 or 1.105.

The request may be fulfilled by asking the attorney(s) of record handling prosecution and the inventor(s)/assignee for references qualifying as prior art. A simple statement that the query has been made and no prior art found is sufficient to fulfill the request. Otherwise, the fee and certification requirements of 37 CFR section 1.97 are waived for those documents submitted in reply to this request. This waiver extends only to those documents within the scope of this request that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this request and any information disclosures beyond the scope of this request are subject to the fee and certification requirements of 37 CFR section 1.97.

In the event documentation (e.g. newly submitted/previously submitted on an IDS, incorporated by reference or "common knowledge" generally found in the background section but not a publication) is determined to qualify as prior art, a discussion of relevant passages, figs. etc. with respect to the claims must be provided. That is, for at least each **independent** claim limitation (including structural and functional limitations linking claim elements, e.g. coupled to,

responsive to) identify a corresponding prior art element by page, line and/or fig. Since applicant is most knowledgeable of the present invention and submitted art, a discussion of the reference(s) with respect to the instant claims is essential.

In the present disclosure, the Background section identifies several prior art devices and/or systems. In response to this Office action, the examiner requests identification of all independent claim limitations (claims 1, 2, 3 and 5) corresponding to prior art elements in the background documentation. Since applicant is most knowledgeable of the present invention and the background art, a discussion of the background art with respect to the instant claims is essential. That is, for each claim limitation (including structural and functional limitations linking claim elements, e.g. coupled to, responsive to) identify a corresponding prior art element by page, line, and/or fig. The examiner is specifically looking for at least the following claim limitations that appear to represent the main invention(s)/embodiment(s). Applicant must specifically state whether or not any of the following elements are found in the Background art.

An address storage circuit for storing address information of a defective memory cell.

A data storage circuit for storing the replacement data of the defective memory cell.

A switching circuit which inputs data from read only storage and data from the data storage circuit and outputs...based on address information.

Plurality of switching circuits.

Rewritable storage device provided with redundancy memory cells.

The examiner also requests, in response to this Office action, a showing of support for the following: All claim language (original independent claim(s) only) that does not have antecedent basis in the descriptive portion of the specification. That is, if support for a claim

limitation(s) resides solely in the original claims, such limitation must be identified; Claim language added to any present claims on amendment and any new claims. Indicate support for the claim language/limitation(s) above (including structural and functional language linking claim elements e.g. coupled to, responsive to) by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s) and the corresponding limitation. This request is derived from 37 CFR 1.105 and will assist in prosecuting the application.

This Office action includes a requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

6. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 10, “the output data” lacks antecedent basis. Line 10, “said two pieces of output data” lacks a clear antecedent.

Regarding claim 2, line 11, “the output data” lacks a clear antecedent. Line 12, “said two pieces of output data” lacks a clear antecedent.

Regarding claim 3, line 12, “the output data” lacks a clear antecedent. Line 13, “said two pieces of output data” lacks a clear antecedent.

Regarding claim 5, line 8, “the output data” lacks a clear antecedent. Line 8, “said two pieces of output data” lacks a clear antecedent.

The remaining claims are rejected as they depend from a rejected base claim.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hotta (Pat. No. 5,452,258).

The claimed "semiconductor device having read only storage" corresponds to the ROM shown in figure 2 of Hotta. The claimed "address storage circuit for storing address information of a defective memory cell" corresponds to address storage 8. The claimed "data storage circuit" corresponds to data storage 9. The claimed "switching circuit" corresponds to switching circuit 7.

The examiner believes all dependent claim features not specifically discussed above are expressly or inherently taught by Hotta. The remaining dependent claim features, while part of the invention, do not appear essential to the main invention found in the independent claims. Thus, a detailed discussion of claim feature(s) is not warranted at this time. Support for this line of reasoning is derived from 37 C.F.R. 1.105. 37 C.F.R. 1.105 permitting "stipulations as to facts" or "whether a dependent claim element is known in the prior art based on the examiner having a reasonable basis for believing so."

Art Unit: 2185

In the event applicant disagrees with the characterization of certain dependent claim elements as being “expressly or inherently” taught by the reference, applicant must specify exactly what claim elements are considered “novel” or “allowable” and why they are allowable (e.g. the claim feature is not suggested/taught in the art of record).

Any response to this action should be mailed to:

Under Secretary of Commerce for Intellectual Property and Director of the
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

or faxed to:

(571) 273-8300, (for Official communications intended for entry)

Or:

(571) 273-4208, (for Non-Official or draft communications, please label
"Non-Official" or "DRAFT")

Any response to this final action should be mailed to:

Box AF

Under Secretary of Commerce for Intellectual Property and Director of the United
States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

or faxed to:

(571) 273-8300, (for Official communications intended for entry)

Or:

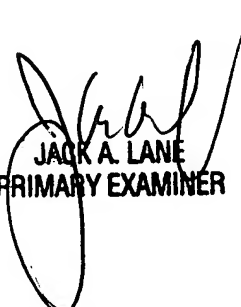
(571) 273-4208, (for Non-Official or Draft communications, please label
"Non-Official" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack A. Lane whose telephone number is 571 272-4208. The examiner can normally be reached on Mon-Fri from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 571 272-4210.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571 272-2100


JACK A. LANE
PRIMARY EXAMINER